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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 515

F. A. SMITH MANUFACTURING CO., INC.,
Petitioner,

vs.

SAMSON-UNITED CORPORATION.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT AND BRIEF IN SUP-
PORT THEREOF.**

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PETITION FOR WRIT OF CERTIORARI.

*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your petitioner, F. A. Smith Manufacturing Co. Inc., prays that a writ of certiorari should issue to review the judgment of the United States Circuit Court of Appeals for the Second Circuit, entered August 28, 1942 (R. 535).

A certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith, in accordance with the Rules of this Court.

Summary Statement of the Matters Involved.

This action was brought in the United States District Court for the Western District of New York, before Harold

P. Burke, Judge, by the Samson-United Corporation vs. F. A. Smith Manufacturing Company, Inc., for infringement of claims 1 to 7 inclusive and claims 15 and 18 of patent No. 2,095,223 (R. 318), granted October 5, 1937, in the name of Abe O. Samuels, Assignor, to Samson-United Corporation, for a "fan". The Samuels patent in suit discloses a fan comprising, (a) a base or supporting bracket, (b) an electric motor mounted on the base or supporting bracket and (c) a fan blade assembly fixed to the shaft of the electric motor and rotated thereby.

The fan blade assembly comprises a bullet shaped metal hub or nosepiece provided with four equally spaced arcuate slots. Through each slot projects a rubber fan blade. The same blade being retained in the slots against centrifugal action, when the motor is operated, by shoulders formed along the base edges of the blade, which shoulders engage with the inner surface of the hub.

Each fan blade is formed or molded flat and when a fan blade is inserted into a slot of the hub, the blade is *conformed* by the engagement of the rubber blade with the slot in the hub, so that the *blade assumes a curved or cup shape*.

Prior to the present suit the Samuels patent had been considered and held valid and infringed by the Circuit Court of Appeals for the Second Circuit upon two occasions.

In the first case, namely, *Samson-United Corporation v. Sears-Roebuck Company*, 103 F. (2d) 312, the Court in considering this patent made the following statements:

"That it was not new to use rubber, as well as other pliable materials for making fan blades, is shown by the British Patent No. 3,203 granted to Siemens Brothers & Co., Ltd., in 1899."

"While the mere use of rubber in making fan blades was no 'invention', the use of a flexible material, which might of course be rubber, in the way the patentee taught how to use it to obtain the desired results by

attaching it in his way to the hub to increase its utility as a fan blade without destroying in any appreciable way its inherent safety qualities, was what the patent law is designed to protect."

"These desirable features were obtained by using flexible blades which, when cupped by insertion into arcuate grooves in the hub, were of sufficient rigidity to withstand the axial thrust required for rotation against air * * *.

Another important feature of construction was a rib at the base of each blade which extended outwardly from the plane of the blade on each side to overlap the inner edges of the sides of the slots in the hollow hub into which the blades were inserted so as to hold the blades immovable by centrifugal force when the fan was in motion."

In the second case, namely, *Samson-United Corporation v. Emanuel, et al.*, 109 F. (2d) 922, the Court said:

"The patent specifications were drawn to an electric fan like those then in common use with the exception of the blades which were made of rubber or other resilient material so cupped by having their bases inserted in arcuate slots in the fan hub that they were given sufficient ability to displace air satisfactorily * * *. * * * These desirable features were imparted to the fan blades by the manner in which they were attached to the hub."

"We were careful to place the emphasis before, not on the use of rubber or any other resilient material for fan blades, but on the way such blades were attached to the hub to give them their new and desirable characteristics."

THE PETITIONER'S (DEFENDANT) ACCUSED FAN STRUCTURE.

The accused structure which is held to infringe the patent in suit, comprises a fan blade assembly in which the hub and blades are made entirely of rubber and cast or molded in one piece, by one molding operation, in which

each fan blade is given the desired shape and is integrally formed with the rubber hub.

THE DEFENSES ADVANCED BY PETITIONER WERE AS FOLLOWS:

1. The accused construction is generically different, particularly in the mode and manner of the association of the rubber fan blades and rubber hub than the construction disclosed in the Samuels patent and do not infringe the claims of that patent, particularly in view of the prior decisions of the Circuit Court of Appeals for the Second Circuit involving the Samuels patent wherein the scope of the said patent was clearly set forth.

2. The Samuels patent is invalid in view of Carlson patent No. 1370284 (R. 458), and Read Patent No. 4391 (R. 468), or in the alternative must be held to be so limited thereby that the distinctive construction of the accused structure could not properly be held to be an infringement thereof.

3. The Samuels patent in suit is invalid because Abe O. Samuels was not the originator or inventor of the fan structure disclosed in the Samuels patent. The subject matter of the patent in suit having been originated by one Marion W. Humphreys and disclosed to Abe O. Samuels who, after such disclosure and unbeknown to Humphreys, filed the application for patent which eventuated in the patent here in suit.

4. The Samuels patent in suit is invalid because in developing the fan blade assembly of the patent in suit, a commercial fan known as the "Gilbert fan" was used as the basis for the development of the patented fan and the originator merely substituted for the metal blade of the "Gilbert fan" a rubber blade which was essentially copied as to size and cup shape from the Gilbert fan, and the method

of attachment of the rubber blades of the patented fan employed the method of attachment used in a similar structure in the commercial "Deal" fan which was also used in connection with the development of the patented fan.

THE DISTRICT COURT.

The District Court found the Samuels patent valid and infringed (R. 502).

In connection with the defense that Samuels was not the original and first inventor but that Marion W. Humphreys originated and disclosed to Samuels the fan structure which is disclosed in the patent in suit, the District Court said:

"Up to the time of the present suit Humphreys has never asserted to Samuels or to the plaintiff any claim that he was the inventor."

His failure to assert against either the plaintiff or Samuels any claim of ownership of the invention or to voice any objection against Samuels claim of ownership until the present suit, is strong evidence that Humphreys was not the inventor and that he never believed himself to be the inventor.

"Under the circumstances as disclosed in this case the evidence tending to show that Humphreys was the first inventor cannot prevail."

The Court cited the case of *Holley-Hill Citrus Growers Association v. Holley-Hill Fruit Products*, 75 F. (2d) 13-17, in which case the Court invoked the doctrine of what it called evidentiary estoppel.

THE COURT OF APPEALS.

The judgment of the District Court was affirmed by the Circuit Court of Appeals, Second Circuit, on August 28, 1942, (R. 535). The decision was by divided court. Judge

Chase writing the opinion for the majority (R. 518) and Judge Frank dissenting with opinion (R. 522).

In the opinion of the Circuit Court of Appeals, the Court, in connection with its sustaining the judgment of the lower Court with respect to the defense urged below that Samuels was not the original and first inventor of the subject matter of the patent in suit, but that Humphreys was the originator said, "The District Judge who had the benefit of observing the witnesses, concluded that Humphreys claim to the invention was not to be believed." In this statement the writer of the opinion for the majority of the Court of Appeals fell into error in stating that the District Judge had the benefit of "observing the witnesses". The fact of the matter is that the witnesses who testified concerning these matters, did not appear in open court but the testimony was taken entirely by deposition as clearly pointed out by Judge Frank in his dissenting opinion. Furthermore, we would point out that the conclusion of the District Judge with respect to the testimony concerning the Humphrey claim of originality, was not primarily based upon any disbelief of the testimony given by the witnesses, but rather because of the failure of Humphrey to sooner assert his claim as to originality of the fan disclosed in the patent in suit, "the evidence tending to show that Humphreys was the first inventor cannot prevail." The District Judge was invoking against the Humphreys claim a species of estoppel.

Questions Presented.

1. Where an alleged inventor has actually studied and had before him a commercially established electric fan in which the fan blade assembly comprises a metal hub with curved or cupped metal blades attached thereto and from that situation produces a fan blade assembly in which the

blades are essentially copied as to size and cup shape except that they are made of rubber instead of metal and where admittedly rubber bladed fans generally were known in the prior art, did it involve invention to make such substitution of rubber blades for metal blades?

2. Where an alleged inventor has actually before him a commercial fan in which the fan blade assembly comprises a metal hub with curved or cupped metal blades attached thereto and also has before him an established commercial fan in which the air propelling elements were of flexible material but of different shape and make-up than those customarily employed with metal bladed fans but where such air propelling elements were secured to the rigid hub by means of a slot in the hub and a cooperating shoulder on the air propelling elements and from that situation produces a fan blade assembly in which the blades are essentially copied as to the size and blade shape of the commercial metal bladed fan except that the blades are made of rubber and where such rubber blades are secured to the hub by means of a slot in the hub and a shoulder on the blade and where admittedly rubber bladed fans generically were known in the prior art, did it involve invention to make such substitution of rubber blades for metal blades and secure the rubber blades to a rigid hub by a construction involving slots in the hub and shoulders on the rubber blades?

3. Where the prior art shows that it was old and known to make a fan blade assembly by casting as an integral structure the hub and fan blades and where the fan blades are curved and cup shaped, did it involve invention to cast as an integral structure in rubber, a similar hub with similar curved fan blades?

4. Whether or not a fan having a blade assembly comprising a hub and curved blades integrally cast or molded

in rubber infringes a patent disclosing a fan having a blade assembly comprising individual rubber blades projecting outwardly through curved slots in a metal nose-piece or hub and wherein the individual rubber blades are initially molded flat and when assembled in the slots of the hub are thereby conformed to a curved or cup shape.

5. Whether or not a fan having a blade assembly comprising a hub and curved blades integrally cast in rubber, infringes a patent disclosing a construction and characteristics set forth in the preceding question and wherein the blade assembly of the accused fan is essentially identical in appearance and construction with a prior art fan blade assembly except for the fact that the blade assembly of the accused fan is made of rubber whereas the prior art blade assembly was made of metal and these fan blade assemblies made of rubber were generically known in the art.

6. Is it error on the part of a court, in refusing to give full faith and credit to the testimony of a witness, whose testimony is corroborated, as to the fact that such witnesses originated the alleged invention claimed in a patent in suit, on the ground or because of the fact that the witness in question had not at any time prior to the suit in which he testified advanced his claim and contention as to origin of the alleged invention, although he knew that the alleged inventor had filed an application for patent (in suit) shortly after such filing had been made, where the witness claiming to be the originator is not a party to the suit but was called as a witness by the defendant, who represents the public, thus essentially invoking an estoppel which is against the public interest.

Reasons Relied Upon for the Granting of the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following reasons:

1. That the decision of the Court of Appeals of the Second Circuit in holding the petitioner's accused rubber fan blade assembly as an infringement of the patent in suit, has enlarged the invention, (if any), beyond that disclosed by the patent itself. This being clearly in derogation of the fundamental holding of the Supreme Court in the case of *Schriber-Schroth Co., v. Cleveland Trust Company*, 305 U. S. 47-57.

2. That the Circuit Court of Appeals for the Second Circuit has sustained as valid a patent and has construed the claims of such patent so broadly that the patent dominates the entire market for curved rubber bladed fans and due to the size and importance of the market embraced within the Second Judicial Circuit, it is exceedingly difficult, if not impossible, as a practical proposition, for the rubber bladed fan industry to operate within this market. Respondent can thus maintain, practically speaking, entire domination of the rubber bladed fan industry without bringing suits outside of the Second Circuit. Thus it is improbable that a conflicting decision will occur in another Circuit.

3. That the decision of the Court of Appeals in this case, is in apparent conflict with the decisions of the Supreme Court in *Cuno Corporation v. Automatic Devices*, 314 U. S. 48; *Altoona Publix Theaters Inc. v. American Tri-Ergon Corporation*, 294 U. S. 477, and *Florsheim v. Schilling*, 137 U. S. 64, on the question of what constitutes invention.

4. That the Court of Appeals for the Second Circuit has erred in their failure to give full faith and credit to the evidence and testimony of witnesses produced to sustain the contention that the patentee was not the true and original inventor of the alleged invention in the patent in suit, on the ground that the alleged prior originator or inventor, (if it be an invention), had not sooner asserted his claim,

thus in effect precluding relief not only against the alleged infringer but also relief to the public from the asserted monopoly.

The action of the Court of Appeals is asserted to be in conflict with the pronouncement of this Court on similar subject matter in the case of *Paramount Publix Theaters Corp. v. American Tri-Ergon Corporation*, 294 U. S. 464, 477.

Wherefore, your petitioners respectfully pray that a writ of certiorari issue out of and under the seal of this Court directed to the United States Court of Appeals for the Second Judicial Circuit, commanding said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this Court, as to the questions herein presented and that the judgment of the Court of Appeals be reversed, and that petitioner may be granted such other and further relief as may seem proper.

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